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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,447	09/13/2000	Helen B. McIntosh	T2739-906589	7855

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MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

EXAMINER

SUHOL, DMITRY

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary

Application No.

09/661,447

Applicant(s)

MCINTOSH, HELEN B.

Examiner

Dmitry Suhol

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-16 is/are pending in the application.
- 4a) Of the above claim(s) 2-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In analyzing claims 9-16 for patent eligible subject matter, it is useful to first answer the question “What did applicant[s] invent?” In re Abele, 214 USPQ 682 (CCPA 1982). The preamble of claim 9 characterizes the invention as a “method of performing conflict resolution ...”, thus the invention is essentially a species of what people and nations have done since time immemorial – communicate to avoid fighting. Stated differently the invention takes old and conventional group discussion to solve conflict and performs that old process in a specific place and by breaking the participants up into smaller groups.

Having determined in general what the invention is, we must analyze it under the prevailing case law. The statute itself allows for the patenting of processes. However, it has been determined in many contexts that not all processes set forth patent eligible subject matter. One test that has recently been applied is whether the invention produces a useful, concrete, tangible result. See e.g., States Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Under that test, the invention

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must have practical utility, it must produce an assured result, and it must not be merely an abstraction lacking in physical substance.

In this case, the claimed method steps are nothing more than movement between participants and items of conversation (both deemed abstract in nature) in which case the claimed invention does not produce a “concrete” result in the sense that it cannot be reasonably assured that conflict resolution will be predictably enabled by the steps set forth as they are drawn to abstract ideas in the first place. Furthermore, there is simply too much subjectivity involved because the process effectively relies on the state of mind of the participants rather than an objective standard, for example, step d of claim 9 allows conflict interaction between group participants however there is nothing to say that such interaction will take place. Actual performance of conflict resolution, much less actual resolution of conflict, is completely up to the participants. The process itself is no more than an attempt and a hoped-for result.

The claimed invention does not produce a “tangible” result in the sense that it merely manipulates abstract ideas without producing a physical transformation or conversion of the subject matter expressed in the claim so as to produce a change of character or condition in some physical object. See In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994); In re Schrader, 30 USPQ2d 1445 (Fed. Cir. 1994). Except for the use of an evaluation form (a peripheral element to the actual process) the remaining steps of the claim are effectively no more than items of conversation and movement between participants that are deemed abstract in nature. Mindful of the need to focus on what the inventor did in fact invent, it is not an evaluation form. The method does

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not produce a physical transformation and yields no tangible result. It is thus effectively a manipulation of abstract ideas and is thus not statutory.

Even if it might be determined that the claimed method can be characterized as producing a useful, concrete, tangible result, to be proper subject matter for patent eligibility, any useful, concrete, tangible result must be within the useful or technological arts. See e.g., In re Musgrave, 167 USPQ 280 (CCPA 1970); In re Foster, 169 USPQ 99 (CCPA 1971). The Constitution empowers Congress to promote the useful arts. The term “useful arts” has been equated with “technological arts” in a number of decisions. See e.g., In re Waldbaum, 173 USPQ 430 (CCPA 1972).

In this case, the claimed invention is not within the useful or technological arts. Rather, the invention is within the realm of the liberal arts or social sciences. In Musgrave and Foster, the inventions were deemed to be within the technological arts. In those cases, each invention clearly involved computer or machine technology. But here, there is no technology involved at all. There is no technology disclosed or claimed. The evaluation form is a peripheral element to the actual process and cannot reasonably convert an otherwise non-statutory process outside the technological arts into one that is in fact within the technological arts.

Claims 9-16 do not produce a useful, concrete, tangible result in the technological arts. The invention as disclosed and claimed does not promote the progress of the useful arts. Accordingly claims 9-16 do not define statutory subject matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-273-4430. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ds

Dmitry Suhol
